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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,391	03/23/2004	Kunio Kondo	12112-0003	2333
22902	7590	11/14/2005	EXAMINER	
CLARK & BRODY 1090 VERMONT AVENUE, NW SUITE 250 WASHINGTON, DC 20005			YEE, DEBORAH	
			ART UNIT	PAPER NUMBER
			1742	

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/806,391	Applicant(s) KONDO, KUNIO	
	Examiner Deborah Yee	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 to 4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese patent 5-202447 (Eiji) for the reasons set forth in office action dated 6-06-05.

Response to Arguments

3. Applicant's arguments filed 9-02-05 have been fully considered but they are not persuasive. The English abstract of Eiji discloses a non-heat treat seamless steel tube having a composition with constituents whose wt% ranges overlap those recited by the claims, such overlap in wt% ranges establishes a prima facie case of obviousness because it would be obvious to one of ordinary skill in the art to select the claimed alloy wt% ranges over the broader disclosure of the prior art since the prior art teaches the same utility and similar properties of high strength and excellent workability and weldability, see MPEP 2144.05. Moreover, Eiji in Table on page 4 discloses specific examples 1 and 11 which closely meet the claimed composition and when calculated, satisfy the claimed Ceq.
4. It was pointed out by applicant that when viewing the table on page 4 of Eiji, it is quite clear that the carbon contents of the exemplified alloys are all much greater than

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0.20%, particularly steel 11 containing 0.26%C. It is the examiner's position that Eiji discloses a C range of 0.2 to 0.45% which overlaps with applicant's range of 0.1 to 0.20%. Moreover Eiji examples 1 and 11 contain 0.2%C and 0.26%C respectively; and hence closely suggest the present invention. Also the claimed C range of 0.10 to 0.20% fails define patentability over prior art C range of 0.2 to 0.45% ; while applicant's specification on page 4 lines 30 to 35 and lines 1 to 3 on page 5 discloses 0.1 to 0.20% carbon is preferred, there is nothing to show (e.g. by comparative test data) that it is critical or that it involves anything more than judicious selection. Note applicant's specification on page 4 teaches 0.10 to 0.25% is permissible, and applicant's comparative test data on page 10 is inadequate because it is not representative of Eiji steel alloy. Note minimum requirement for comparative test data is to be with the closest prior art examples.

5. It was argued that Eiji does not meet the C_{eq} or have a bainite structure. It is the examiner's position that when calculated, prior art steels 1 and 11 on page 4 meet the C_{eq} requirement recited by the present invention. Moreover, since composition and properties are closely met, then bainite structure would be expected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on Monday-Friday from 6:00 to 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Deborah Yee
Primary Examiner
Art Unit 1742

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